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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,044	08/30/2006	Roy Olson	95727-P1744	6950
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EXAMINER				
SEVERSON, JEREMY R				
ART UNIT		PAPER NUMBER		
3653				
MAIL DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/552,044

**Applicant(s)**

OLSON, ROY

**Examiner**

Jeremy Severson

**Art Unit**

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-08)
- Paper No(s)/Mail Date 10/3/05
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

## **ETAILED ACTION**

### ***Claim Objections***

The claims are objected to because of the following informalities:

Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP 608.01(i)-(p).

In claim 1, 16, the space in the word "openable" should be deleted.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 25 and 26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. The claims are nominally method claims, and method steps are recited in claim 25. However, claim 25 recites "a feeding device;" and claim 26 recites "a magnetic sorting device" with no method steps. See also 35 USC 112 rejection, below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "control/affect" in claim 14 is ambiguous since it is not clear precisely what it means. For example, it could mean "control and affect," "control or affect" or it could be implying that control and affect are synonymous. Use of the terms "position/retain" in claim 17 and "stop/positioning device" are ambiguous for similar reasons.

Regarding claim 16, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 22 recites "a compression unit" and "a sorting unit." It is unclear whether this is the same compression unit and sorting unit recited in claim 14.

Regarding claims 25 and 26, a single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph. *IPXL Holdings v. Amazon.com, Inc.*, 430 F.2d 1377, 1384, 77 USPQ2d 1140, 1145 (Fed. Cir. 2005); *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990). See also 35 USC 101 rejection, above.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Park (US 6,684,763).

Regarding claim 14, Park discloses a handling device for returnable packagings comprising a feeding device, having at least one inlet opening, a first detection device 124 arranged in connection with said feeding device, means for detection of at least one property of the material of a returnable packaging, in order to control/affect the operation in a subsequent sorting unit, wherein a lock unit is arranged before said sorting unit, and a compression unit, wherein said lock unit comprises a first 126 and a second 122 stop device, arranged to control that only one returnable packaging at a time is present at said second stop device, wherein said means comprises a second detection device 123 arranged within said feeding device, which second detection device includes a gauge arranged to distinguish between metal and plastic, and that said sorting unit 144 is moveable arranged, between different positions, based on a control signal from said second detection device, in order to dependent of its material direct the returnable packaging into one of at least two different directions.

Regarding claim 15, Park discloses a handling device according to claim 14, wherein the first stop device is arranged to be closed when a returnable packaging is in a position between the first and the second stop device. See fig. 12b-1.

Regarding claim 16, Park discloses a handling device according to claim 15, wherein the first stop device 126 is arranged to be openable when there is no returnable packaging present between the first and the second stop device.

Regarding claim 17, Park discloses a handling device according to claims 14, wherein the second stop device 122 is arranged to be open when a positioning device is empty and in position to position/retain a returnable packaging for detection, by the second detection device 123.

Regarding claim 18, Park discloses a handling device according to claims 15, wherein the second stop device 122 is arranged to be open when a positioning device is empty and in position to position/retain a returnable packaging for detection, by the second detection device 123.

Regarding claim 19, Park discloses a handling device according to claims 16, wherein the second stop device 122 is arranged to be open when a positioning device is empty and in position to position/retain a returnable packaging for detection, by the second detection device 123.

Regarding claim 20, Park discloses a handling device according to claim 14, wherein the feeding device is continuously acting on returnable packagings.

Regarding claim 21, Park discloses a handling device according to claim 20, wherein the feeding device is continuously acting on returnable packagings by gravity.

Regarding claim 22, Park discloses a handling device according to claim 14, wherein a compression unit 132 is arranged after the feeding device and before a sorting unit 144.

Regarding claim 23, Park discloses a handling device according to claim 14, wherein at least one stop/positioning device 122 is arranged in the form of a holder-on arranged to position a returnable packaging by preventing its continued movement through the feeding device.

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Park in view of Wergeland (US 5,249,689).

Park discloses everything except Park does not explicitly disclose that said second gauge comprises at least one inductive gauge. Wergeland teaches the use of an inductive gauge in order to sense the type of material of cans. Col. 6, lines 1-5. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use an inductive gauge as the second gauge of Park, as taught by Wergeland, in order to sense the type of material of cans.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy Severson whose telephone number is (571)272-2209. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey, can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/  
Supervisory Patent Examiner, Art  
Unit 3653

JRS